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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 10/085,081 | 03/01/2002 | Takayuki Yamamoto | 220119US0 | 9114 |

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ALEXANDRIA, VA 22314

EXAMINER

UHLIR, NIKOLAS J

| ART UNIT | PAPER NUMBER |
|----------|--------------|
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1773

DATE MAILED: 11/14/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action

Application No.

10/085,081

Applicant(s)

YAMAMOTO ET AL.

Examiner

Nikolas J. Uhler

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--Th MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 10/30/03 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.
- ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on _____. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☐ The proposed amendment(s) will not be entered because:
- (a) ☐ they raise new issues that would require further consideration and/or search (see NOTE below);
- (b) ☐ they raise the issue of new matter (see Note below);
- (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
- (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____

3. ☐ Applicant's reply has overcome the following rejection(s): none.
4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: see attached sheet.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☐ will not be entered or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: none.Claim(s) objected to: none.Claim(s) rejected: 1-4, 6 and 8-11.Claim(s) withdrawn from consideration: none.

8. ☐ The drawing correction filed on _____ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____
10. ☐ Other: _____

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Note regarding box 5(c): The request for reconsideration has been considered but is not persuasive. The applicant in his arguments relies on the same showing of "unexpected" results that have been presented earlier. The examiner maintains that this showing is not sufficient to overcome the prior art.

First, the showing of unexpected results is not persuasive in light of the fact that the cited prior art (Shinohara) teaches a coating for a steel sheet that is analogous to the claimed coating. The applicant argues that the combination of zinc powder and rust inhibitor results in unexpectedly improved corrosion resistance. However, the Shinohara coating contains zinc powder and a rust inhibitor, wherein the amount of zinc powder and rust inhibitor are expressed in ranges that have at least one endpoint that completely encompassed by the claimed ranges for these components. Further, the type of rust inhibitor can be calcium or aluminum phosphate, which are listed on page 4 of the instant specification as suitable for use as a rust inhibitor that is more basic than zinc powder.

In addition, the showing of unexpected results is unpersuasive because the data cited in support only provides a comparison between a coating composition that contains both zinc powder and a rust inhibitor more ^{basic} ~~base~~ than zinc, and a coating composition that contains only zinc powder. As there is no comparison between coatings containing zinc powder and a rust inhibitor more basic than zinc and a coating containing zinc powder and rust inhibitor that is ^{equal or} less basic than zinc, there is no basis on which to determine whether the results shown by the applicant are truly unexpected.

Further, there is no data provided that establishes a comparison between the cited prior

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art and that of the instant invention. Thus, there is no basis by which to establish that the claimed invention produces unexpectedly improved properties over that of the cited prior art.

Thus, the examiner maintains that the applicant's showing of "unexpected" results is insufficient to overcome the cited prior art.


D. S. NAKARANI
PRIMARY EXAMINER, Acting SPE